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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,044	10/10/2001	Christopher Robert Cox	P66623US1	7330

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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,044

Applicant(s)

COX ET AL.

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 and 17 of copending Application No. 09/684,129 in view of Warther et al. ('356). Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the present claims and the co-pending claims is the present claims claim "at least one of a front and a rear card panel" and "a magnetic strip patch immovably secured over said card region on an outer surface of a magnetic strip panel" and the co-pending claims claim "a front and a rear card panel". The present claims are claiming that there could be one or more front and rear card panels. The co-pending claims are claiming that there is only one front and rear card panel. Since the present claims claim at least one front and rear card panel, one having ordinary skill in the art would conclude that it would have been obvious to provide only one set of front

Art Unit: 3722

and rear card panels as presently disclosed in both the present claims and the co-pending claims. Further, Warther et al. disclose a printed sheet having a plurality of scored cards having front and rear card panels situated in a side-by-side relationship with encoded magnetic strips (as seen in figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the present claims ('129) to include more than one card panel having front and rear card panels having encoded magnetic strips, as taught by Warther, to enable the user to manufacture a number of cards using one single sheet of paper, thus reducing the cost associated with printing the individual cards and provide encoded information on the cards.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chess ('201) in view of Warther et al. ('356).

Chess discloses an integrated card construction comprising a carrier sheet having printed information, the printed information containing in part card information printed at a predetermined location on a front face of the carrier sheet in a card region of the sheet and oriented to be disposed on an outer surface of a front (50) and rear

Art Unit: 3722

(50) card panel of a card to be formed (see figure 1 and col. 1, lines 22-26), a siliconized liner patch (60 – translucent or transparent paper base liner or backing patch with a suitable varnish 62) containing a pressure-sensitive adhesive surface (58) laminated on a back surface of the carrier sheet and disposed to extend over the card region (as seen in figure 3A), a face patch of clear poly material (64- see col. 3, lines 59-67) immovably secured over the card region on the front face of the carrier sheet, a die cut (61) delineates the front and rear card panels and a straight fold line (61 – as seen in figure 1) in the face patch between the front and rear card panels.

It is noted that the manner in which the card is formed (i.e., "said card being formable by peeling....said pressure-sensitive adhesive together."), does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Chess discloses the claimed invention except for the card being a card being a magnetic strip card and wherein the face patch contains a magnetic strip oriented across one of the card panels and the die-cut extending through the magnetic strip at opposed edges of the card; the magnetic strip being oriented on the rear panel and disposed spaced and parallel to a lower edge of the rear panel; the printed information on the rear panel including one or more bar codes for containing specific coded information, the magnetic strip being compatible for use in an encoder/reader machine; the magnetic strip containing personalized information; and two front and rear card panels disposed in the card region and disposed spaced in side-by-side relationship.

Art Unit: 3722

Warther et al. disclose printed sheet products comprising transaction cards spaced in side-by-side relationship (as seen in fig. 1) having magnetic stripes (col. 12, lines 16-28) oriented across the card panel. The card (such as element 671) is die-cut (671a) to enable removal of the card from the sheet. The die-cut extends through the magnetic stripe (see fig. 16). Warther et al. also disclose the use of unique codes printed on the transaction cards. The unique codes comprise machine-readable bar codes encoded with information. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Chess's invention to include magnetized indicia, as taught by Warther et al., providing the cards with a security element that enables the card to be authenticated and/or verified by a machine. Authentication of the card may be necessary to verify the proper identity of the user.

Response to Arguments

4. Applicant's arguments with respect to claims 15-20 have been considered but are moot in view of the new ground(s) of rejection.

Note: Applicant's remarks with respect to the provisional rejections of claims 15-24 under the judicially created doctrine of obviousness-type double patenting are duly noted.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-

Art Unit: 3722

0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

July 14, 2003


MONICA CARTER
PATENT EXAMINER